

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action and interview, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claims 1 and 12-24 remain in this application. Claim 24 has been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present that claim in a divisional application.

The Examiner objected to the specification for not having titles. Titles have been provided by amendment. The specification has also been amended to incorporate material from claim 9 as originally filed. No new matter has been added as a result of these amendments.

As an initial matter, Applicant's representative would like to express his displeasure at the fact that the Examiner has maintained her rejections to a number of the claims, despite the fact that, at a personal interview with her supervisor, both the Supervisor and the Examiner agreed with applicant, that Moser did not appear to teach any connection between a hearing device and the audiometer system. It was pointed out at the interview that Fig. 16 of the reference makes clear that the system of Moser merely outputs an audio signal to a speaker 310 in the measuring box 312, with the audio signal being picked up by a hearing aid in the box 312, and then the hearing aid outputs an audio signal picked up by the microphone 325 via a coupling chamber 326. It was pointed out that applicant's representative could find no teaching of any connection between the hearing aid and the system as recited in the claims.

Despite both the Examiner and her supervisor agreeing with this observation, the Examiner has maintained her rejection for a number of the claims, without any explanation as to why the above observations are incorrect. Although it is clear that the Examiner must have changed her mind, there is no indication in the Office action as to why, which makes it difficult for applicant to respond to the rejections, not having any indication as to what teachings the Examiner is using that were not

previously (or herein) discussed. This increases the applicant's costs and unfairly delays the prosecution of this case.

Applicant has requested a certified copy of the priority document and will forward it to the Examiner when it is received.

Claims 14-19, and 21 are rejected under 35 U.S.C. §112, second paragraph. For the following reasons, the rejection is respectfully traversed.

Claims 17-19, and 21 have been amended to correct errors in antecedent basis, making the rejections for that mistake moot. Furthermore, the Examiner stated that she is not clear about what is meant by a "data input connected to a human input device", which in the amended claims reads a "connection for data entry connected to the human input device". Applicant does not understand the Examiner's problem. What is unclear about connecting a human input device (such as a mouse, keyboard, etc.) to another connection or input to another device? Applicant believes that the language is clear and not indefinite. Finally, the Examiner argues that "said decoding unit is not operationally connected with another input of said computing device". Applicant points to the original language of claim 9, which has been added to the specification, in combination with Figs. 1 and 7, and the connection E3, as teaching the cited connection between the decoding unit and the computing unit. Accordingly, the rejection should be withdrawn.

Regarding claim 14, the Examiner states that the claim is misdescriptive because, although "testing is done, it is not clear that a testing unit is present." Applicant does not understand the Examiner's rejection. Claim 14 recites a hearing fitting device:

further comprising a testing unit that tests the audio storage medium in said playback unit for a predetermined identification and which disables said playback unit on non-recognition of said predetermined identification.

By the clear claim language, the fitting device of claim 14 includes a testing unit that tests the audio storage medium. How the examiner concludes that "it is not clear that a testing unit is present" is not explained. Applicant asserts that the language is

not at all misdescriptive, and thus the rejection of claim 14 is improper, and should be withdrawn.

Regarding claim 15, the Examiner argues that the claim language states that the computing unit comprises the decoding unit, but the specification states that the decoding unit is on the computing unit. Applicant argues that there is no inconsistency there, as something can be both “on” and “part of” something else. For example, applicant’s representative has a Cleveland Indian’s logo “on” his baseball cap that is also clearly “a part of” his baseball cap. However, applicant has amended the claim, making the rejection moot.

Claims 1, 12, 13, 16, 17, 20, 22 and 23 were rejected under 35 U.S.C. §102(b) as being unpatentable over Moser *et.al.* (WO 85/00509). For the following reasons, the rejection is respectfully traversed.

As an initial matter, applicant is unsure whether the Examiner is rejecting the claims based on obviousness or anticipation. The Examiner references 35 U.S.C. §102(b), but makes the statement that the claims are “unpatentable” over the reference, which is language typically used for obviousness rejections. Applicant will assume that the rejection is for anticipation.

As discussed previously, in detail at the personal interview with the Examiner and the Examiner’s supervisor, and in a prior filed response, claim 1 is directed toward a hearing device fitting device with a connection for *connecting to the hearing device*. Moser does not teach any connection to a hearing device. This was clearly pointed out to the Examiner in the personal interview. Instead, Moser shows a hearing aid that is subjected to an audio signal from a device (see Fig. 16), but there is no connection from the device to the hearing aid. A close reading of Moser supports that Moser does not teach any such connection. At the personal interview, both the Examiner and the Examiner’s supervisor agreed that there did not appear to be any such connection taught by Moser. Applicant is at a loss as to why the Examiner has maintained this rejection, specifically considering that the Examiner has not even addressed the issues raised at the interview in the current Office action. Accordingly, claim 1 is patentable over the reference for these reasons.

Claim 20 has similar limitations directed at a connection to a hearing device, and thus is patentable over the reference for at least the same reasons.

Claim 12 recites that "said playback unit contains at least one audio storage chip." The Examiner states that Moser teaches that "the information stored on the compact disc (54) is listed in a stored table of contents" (page 18, lines 30-33). The Examiner then concludes that "inherently some sort of audio storage chip" is present.

The Examiner is reminded of the requirements for a finding of inherency. It is not enough to merely allege that a function or feature is "inherent". The Examiner must provide evidence and or rationale to show inherency. MPEP §2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is *not sufficient* to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art) (emphasis added); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112.

The Examiner has failed to provide any argument as to why an audio storage chip is "necessary" in order to perform the teaching of the reference. For example, why can't the table be stored on the compact disc, or on a hard drive? There is no requirement that an audio storage chip be used. It is possible that audio storage chip *may* be used, to perform the function, but it is not *necessary* that it be used, as

there are other solutions, and the reference does not teach it being used. Accordingly, the audio storage chip is not properly found inherent, and claim 12 is patentable over the reference.

Claim 16 adds a number of limitations providing further detail over the invention of claim 12. However, the Examiner's rejection of claim 16 merely states that "all elements of claim 16 are comprehended by claim 1". Applicant does not understand the rejection. The Examiner has failed to show where the reference teaches the additional limitations of claim 16. For example, where does Moser teach a "set-value comparing unit" as limited by the claim? The Examiner does not say, and applicant can find no such unit. As an additional example, where does Moser teach a "level detector control signal for controlling an operational connection between a level detector output of said level detector and a computing unit control input of said computing unit"? Again, the Examiner does not say. Because the Examiner has failed to show that Moser anticipates the elements of claim 16, claim 16 is patentable over the reference. Furthermore, because claim 16 depends on claim 1, it is patentable over the reference for the same reason as claim 1, as well.

Claim 17 is treated similar to claim 16 by the Examiner, but is patentable over the reference for at least the same reason as claim 1, upon which it depends.

Claim 22 explicitly recites that the computing unit includes a "hearing device output for operationally connecting to the hearing device for programming said hearing device". The Examiner points to page 28-page 29 of the reference as teaching this limitation, but that cited section is totally silent as to how the hearing aid is adjusted, and as is clear from Fig. 16, there is no teaching of any input to the hearing aid for adjusting the hearing aid. Accordingly, claim 22 is patentable over the reference.

The Examiner has failed to reject claims 14-15, 18, 19, and 21 under any of the references, and thus those claims are patentable over Moser.

Furthermore, the Examiner has provided no discussion as to how the reference anticipates claim 23, which is directed toward a method for fitting a hearing device in situ including the steps of "subjecting the individual to an audio test signal" and "having the individual appraise said audio test signal" and "automatically selecting, in dependency of said appraising, a subsequent audio test signal". The

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reference does not teach these steps, and thus claim 23 is patentable over the reference.

Claim 23 was rejected under 35 U.S.C. §102(e) as being unpatentable over Basseas (U.S. 6,674,867). For the following reasons, the rejection is respectfully traversed.

Claim 23 recites the steps identified above. A detailed review of Basseas shows no teaching of "automatically selecting, in dependency of said appraising, a subsequent audio test signal". In fact, the reference is silent as to how audio signals are selected or played during a test, and the sections cited by the Examiner do not teach any such step. Accordingly, claim 23 is patentable over the reference.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 31949.

Respectfully submitted,
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